

Application No. 10/608,545
Amendment Dated January 21, 2005
Reply to Office Communication of September 20, 2004

REMARKS/ARGUMENTS:

This Response responds to the Office Communication dated September 20, 2004. Claims 23 – 40 and 52 – 67 are canceled, and claims 41 and 44 are amended. Claims 41 – 51 are pending in the application, with claims 41 and 49 being independent claims. No new matter has been added to the amended claims.

OATH/DECLARATION

In paragraph 2, the declaration is alleged to be defective because it does not state that the inventor has reviewed and understood the Preliminary Amendment filed December 29, 2004 after the continuation application filing date of June 30, 2003.

However, as stated in MPEP § 602.05(a), “[a] copy of the oath or declaration from a prior non-provisional application may be filed in a continuation or divisional application even if the specification for the continuation or divisional application is different from that of the prior application, in that revisions have been made to clarify the text to incorporate amendments made in the prior application, or to make other changes provided the changes do not constitute new matter relative to the prior application”. Since the December 30, 2003 Preliminary Amendment did not add new matter to the continuation application, there is no need to file a new declaration. Therefore, the copy of the declaration filed with the continuation from the prior application (09/852,846) is proper for this continuation application, and the holding of the declaration being defective should be withdrawn.

ELECTION/RESTRICTIONS

Since Applicant has cancelled claims 23-40 and 52-67, and since only claims 41-51 are currently pending in this application, Applicant believes the Election/Restriction requirement has been rendered moot.

DOUBLE PATENTING

In paragraphs 4 and 5, claims 23 – 48 and 52 – 67 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 37 of U.S. Patent No. 6,589,280. The enclosed Terminal Disclaimer obviates this rejection with regard to pending claims 41 - 48.

CLAIM OBJECTIONS

In paragraph 6, claims 23, 41, 44, 52 and 61 are objected to for various informalities. The above amendments to claims 41 and 44 and the cancellation of claims 23, 52 and 61 obviate the noted claim objections.

CLAIM REJECTIONS UNDER 35 U.S.C. § 112

In paragraph 8, claim 51 is rejected under 35 U.S.C. § 112, first paragraph, because the claimed subject matter is allegedly not described in the specification. As noted in paragraph [0040] of the Application, “[p]referably, multiple rings 16” are placed under the flap, as shown in Fig. 13. The lenses are placed or positioned in concentric circles of about 3, 4 and/or 5 millimeters around the main optical axis, each having a different refractive power, thus allowing multifocal vision”. Thus, a first lens portion may be disposed at about 3 millimeters from the main optical axis and a second lens portion may be disposed at about 5 millimeters, as shown in FIG. 13. Since each lens may be about one millimeter thick, the distance between the outer diameter of the first lens portion and the inner diameter of the second lens portion is approximately one millimeter. Therefore, the specification and figures satisfy the written description requirement by reasonably conveying the subject matter recited in claim 51 to one skilled in the art, and the rejection under 35 U.S.C. § 112, first paragraph, should be withdrawn.

In paragraph 10, claims 30, 41 – 48, 59 and 62 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention.

Since claims 30, 59 and 62 are canceled, the rejection of claims 30, 59 and 62 is rendered moot.

Claims 41 – 48 are rejected under 35 U.S.C. § 112, second paragraph, because “the main optical axis” lacks antecedent basis. The amendment to claim 41 to change “the main optical axis” to “the optical axis” obviates this rejection.

Claim 43 is rejected under 35 U.S.C. § 112, second paragraph, because “the optical axis of them” lacks antecedent basis and is alleged to be vague. The amendment to claim 43 to change “the optical axis of them” to “the optical axis of the eye” obviates this rejection.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

In paragraph 12, claims 23 – 25, 28 – 33, 35, 37 – 46, 48 – 54, 56, 58 – 64, 66 and 67 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,964,748 to Peyman in view of U.S. Patent No. 4,906,245 to Grendahl. Due to the current claim cancellations, this rejection pertains only to claims 41 – 46 and 48 – 51.

The Peyman ‘748 patent discloses a method of modifying a live cornea to correct a patient’s vision. Ocular material or implant 430 may have a substantially annular ring shape with a center opening or circular hole 432, as shown in FIGS. 41 and 42. A plurality of such implants can be disposed at selected locations within a pocked 426 formed in the cornea 412. The Peyman ‘748 patent does not disclose or suggest disposing the ocular implants concentrically to one another as recited in Applicant’s independent claims 41 and 49.

The Grendahl ‘245 patent discloses using a single lens in the eye. There is no disclosure of using more than one lens, as suggested by the Examiner. Therefore, having only a single lens in the eye, the Grendahl ‘245 patent does not disclose arranging a second lens concentrically with a first lens, as recited in Applicant’s independent claims 41 and 49.

Moreover, one of the stated objectives of the Peyman ‘748 patent is to “provide a method for modifying corneal curvature without operating on the center area of the cornea”. Col. 3., lines 25 – 27. The Peyman ‘748 patent further states that the method includes “separating an internal area of the live cornea offset from the main optical axis into first and second opposed internal surfaces via the slit such that an area centered about the main optical

axis remains attached between the first and second internal surfaces". Col. 3, lines 51 – 55. Therefore, the Peyman '748 patent teaches away from placing substantially concentric first and second lenses substantially centered about the optical axis of the eye, as recited in independent claim 41.

Therefore, the combination of the Peyman '748 and Grendahl '245 patents does not disclose or render obvious the claimed features of Applicant's invention, as recited in independent claims 41 and 49, such that claims 41 and 49 are allowable.

Claims 42 – 48, and 50 - 51, being dependent upon claims 41 and 49, are also allowable for the above reasons. Moreover, these dependent claims recite additional features further distinguishing them over the cited patents, such as placing at least one of the first and second lenses substantially concentrically about the optical axis of the eye of claim 42; and the first lens portion having a refractive index different from the refractive index of the cornea of claim 50. Therefore, dependent claims 42 – 48 and 50 - 51 are not anticipated or rendered obvious by the cited patents, particularly within the overall claimed combination

In paragraph 13, claims 26, 27, 34, 36, 47, 55, 57 and 65 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,964,748 to Peyman in view of U.S. Patent No. 4,906,245 to Grendahl and further in view of U.S. Patent No. 6,228,113 to Kaufman. Due to the current claim cancellations, this rejection pertains only to claim 47.

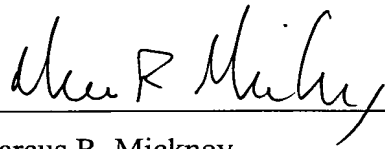
The Kaufman '113 patent is cited for disclosing using 60 lenses with power intervals from +5D to -5D at 0.25D intervals to improve/correct a patient's visual disorder. However, the Kaufman '113 patent does not cure the above-discussed deficiencies of the Peyman '748 and Grendahl '245 patents. Since the Peyman '748, Grendahl '245, and Kaufman '113 patents do not disclose or render obvious all of the limitations in amended independent claim 41, claim 41 is allowable. Therefore, claim 47, being dependent upon claim 41, is also allowable.

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In view of the foregoing amendments and comments, Applicant respectfully submits that claims 41 - 51 are allowable over the cited patents. Prompt and favorable action is solicited.

Respectfully Submitted,

A handwritten signature in cursive script, appearing to read "Marcus R. Mickney", is written over a horizontal line.

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